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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.       |
|--|-------------|----------------------|---------------------------------|------------------------|
| 10/518,190   | 12/16/2004  | Hans Rainer Willmen  | P / 37 - 181                    | 5572                   |
| <div>2352                      7590                      05/24/2007<br/>OSTROLENK FABER GERB &amp; SOFFEN<br/>1180 AVENUE OF THE AMERICAS<br/>NEW YORK, NY 100368403</div> |             |                      |                                 |                        |
|  |             |                      | EXAMINER<br>WOODALL, NICHOLAS W |                        |
|  |             |                      | ART UNIT<br>3733                | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>05/24/2007         | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/518,190

Applicant(s)

WILLMEN, HANS RAINER

Examiner

Nicholas Woodall

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to applicant's amendment received on 04/23/2007.

#### ***Allowable Subject Matter***

2. The indicated allowability of claims 3-5, 8, and 9 is withdrawn in view of the newly discovered reference(s) to Reidel and Gundy. Rejections based on the newly cited reference(s) follow. Therefore, the finality of the previous office action is also withdrawn.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 3, 7, 9, and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabor (U.S. 3,710,674) in view of West JR (U.S. Publication 2003/0074002).

Regarding claims 3, 7, 9, and 11-15, Tabor discloses a device having a circular cross-section that is conically shaped on the outside and tapers from a head part to a base part of the device. The device further comprises a through-hole along the length of the dowel. The device further comprises a continuous longitudinal slit that provides a continuous C-shaped cross-section of the dowel. The head part of the device is comprised of a flange integrally formed onto the device. Tabor further discloses the device to comprise a bevel in the area of the longitudinal slit that decreases from the head part inward. Tabor fails to disclose the head part of the device also including a

bevel. West JR teaches of an anchor device wherein the head of the device comprises a beveled surface that extends from the head part inward in order to enable the device to lay substantially flush with the exterior surface of the bone that the device is inserted into (page 4 paragraph 46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Tabor to further include a bevel on the head part of the device in view of West JR in order to enable the device to lay substantially flush with the exterior surface of the bone that the device is inserted into.

Further regarding claims 3, 9, and 11-15, the combination of Tabor and West JR disclose the invention as claimed except for the bore having a uniform cross-section along the entire length of the device, it is noted that it would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the device of Tabor modified by West JR with a uniform bore, since applicant has not disclosed that such solve any stated problem or is anything than one of numerous shapes or configurations a person ordinary with ordinary skill in the art would find obvious the purpose of providing a uniform bore in the device. In re Dailey and Eilers, 149 USPQ 47 (1966).

2. Claims 2, 3, 6, 7, and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabor (U.S. 3,710,674) in view of West JR (U.S. Publication 2003/0074002) further in view of Overaker (U.S. Patent 6,942,666).

Regarding claims 2, 3, 6, 7, and 9-15, the combination of Tabor and West JR disclose the invention as claimed except for the head of the device having a

Art Unit: 3733

countersink, conically shaped annular ribs on the outer surface that are designed with sharp edges, steep flanks directed towards the head of the device and gentle flanks directed towards the base of the device that extend as far as the steep flank of the next annular rib and are spaced axially along the length of the device, and the device being manufactured from an absorbable material. Overaker teaches a device wherein the head part of the device includes a countersink, the device further comprising conically shaped annular ribs on the outer surface that are designed with sharp edges, steep flanks directed towards the head of the device and gentle flanks directed towards the base of the device that extend as far as the steep flank of the next annular rib and are spaced axially along the length of the device, and the device being manufactured from an absorbable material such as glass or ceramic (column 6 lines 66-67 and column 7 lines 1-32) in order to serve as a receiving surface for the insertion of an expander member (column 3 lines 4-11), for engaging the bone tissue within a bone opening (column 3 lines 18-25), and to act as a therapeutic agent release matrix (column 6 lines 62-67, column 7 lines 1-67, and column 8 lines 1-16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Tabor modified by West JR with the head of the device having a countersink, conically shaped annular ribs on the outer surface that are designed with sharp edges, steep flanks directed towards the head of the device and gentle flanks directed towards the base of the device that extend as far as the steep flank of the next annular rib and are spaced axially along the length of the device, and the device being manufactured from an absorbable material in view of Overaker in order to serve as a

Art Unit: 3733

receiving surface for the insertion of an expander member (column 3 lines 4-11), for engaging the bone tissue within a bone opening (column 3 lines 18-25), and to act as a therapeutic agent release matrix (column 6 lines 62-67, column 7 lines 1-67, and column 8 lines 1-16).

3. Claims 2-8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabor (U.S. 3,710,674) in view of West JR (U.S. Publication 2003/0074002) further in view of Overaker (U.S. Patent 6,942,666) further in view of Reidel (U.S. Patent 4,340,330).

Regarding claims 2-8 and 10-14, the combination of Tabor, West JR, and Overaker, disclose the invention as claimed except for the device further including longitudinal ribs that are mutually offset around the circumference of the device and that taper in height from the head of the device toward the first annular rib. Reidel teaches a device further comprising longitudinal ribs that are mutually offset around the circumference of the device and that taper in height from the head of the device toward the first annular rib in order to prevent rotation of the device while in a bore (column 2 lines 53-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Tabor modified by West JR further modified by Overaker to further include longitudinal ribs that are mutually offset around the circumference of the device and that taper in height from the head of the device toward the first annular rib in view of Reidel in order to prevent rotation of the device while in a bore.

Art Unit: 3733

4. Claims 2-8 and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabor (U.S. 3,710,674) in view of West JR (U.S. Publication 2003/0074002) further in view of Overaker (U.S. Patent 6,942,666) further in view of Reidel (U.S. Patent 4,340,330) further in view of Gundy (U.S. Patent 5,641,256).

Regarding claims 2-8 and 10-14, the combination of Tabor, West JR, Overaker, and Reidel disclose the invention as claimed except for the device further including longitudinal webs extending between annular ribs having a maximum height matching the radial height of the annular ribs. Gundy teaches a device further comprising longitudinal webs extending between annular ribs having a maximum height matching the radial height of the annular ribs in order to prevent rotation of the device while in a substrate material (column 4 lines 39-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Tabor modified by West JR modified by Overaker further modified by Reidel to further include longitudinal webs extending between annular ribs having a maximum height matching the radial height of the annular ribs in view of Gundy in order to prevent rotation of the device while in a substrate material.

5. Claims 9 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabor (U.S. 3,710,674) in view of West JR (U.S. Publication 2003/0074002) further in view of Overaker (U.S. Patent 6,942,666) further in view of DiPoto (U.S. Patent 5,690,676).

Regarding claims 9 and 15, the combination of Tabor, West JR, and Overaker disclose the invention as claimed except for the last annular rib merging into a dome

shape base at the distal end of the device. DiPoto teaches a device wherein the last annular rib merges into a dome shaped base at the distal end of the device in order to ease placement and insertion of the device (column 5 lines 41-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Tabor modified by West JR further modified by Overaker wherein the last annular rib merged into a dome shaped base at the distal end of the device in view of DiPoto in order to ease placement and insertion of the device.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 2-15 have been considered but are moot in view of the new ground(s) of rejection. The examiner has presented new grounds of rejection based on newly cited art as discussed above. Since the examiner has withdrawn previously indicated allowability for claims 3-5, 8, and 9 the finality of the previous office action has been withdrawn and this office action is non-final.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..



Art Unit: 3733

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SUPERVISORY PATENT EXAMINER